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In the Supreme Court of the United States

OCTOBER TERM, 1959.

No. 622

DON L. RUBENFIELD,
Petitioner,

vs.

ROBERT C. WATSON,
Commissioner of Patents,
Respondent.

PETITION FOR A WRIT OF CERTIORARI
To the United States Court of
Customs and Patent Appeals.

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In the Supreme Court of the United States

OCTOBER TERM, 1959.

No.

IN THE MATTER OF THE APPLICATION OF
DON L. RUBENFIELD.

PETITION FOR A WRIT OF CERTIORARI
To the United States Court of
Customs and Patent Appeals.

Don L. Rubinfield prays that a writ of certiorari issue to review the judgment of the United States Court of Customs and Patent Appeals, entered in the above-entitled case on October 15, 1959. The decision upon which said judgment is based was given in an opinion dated May 22, 1959. A petition for rehearing was denied on October 6, 1959.

CITATIONS TO OPINION BELOW.

The opinion of the Court of Customs and Patent Appeals is printed in the Appendix A and was reported in 47 CCPA ; 123 USPQ 210; 270 F. 2d 391. The judgment entered on October 15, 1959 is printed in Appendix B.

JURISDICTION.

The judgment of the Court of Customs and Patent Appeals was entered October 15, 1959 (Appendix B). A Petition For Rehearing of the decision in an opinion dated May 22, 1959 (Appendix A) was denied October 6, 1959. The jurisdiction of this Court is invoked under 28 USC Section 1256.

QUESTION PRESENTED.

Whether by an arbitrary rule of the United States Patent Office applicable to all design patent applications, an applicant for a design patent showing in his application more than one embodiment or modification of his design invention may be limited to but a single patent claim without consideration of the differences in kind or degree that may appear in the plurality of design embodiments or modifications shown.

STATUTES AND PATENT OFFICE RULES INVOLVED.

The statutory provisions involved are 35 USC 112; 35 USC 121; 35 USC 171 and 35 USC 173. They are printed in Appendix C.

The Patent Office Rules involved are Rule 75 and Rule 153. They are printed in Appendix D.

STATEMENT.

On October 29, 1954, petitioner filed in the United States Patent Office his application Serial No. D-32,875 for a patent upon his design invention for a floor waxer.

This design application (R. 3) discloses a design for an article of manufacture, to-wit: a floor waxer. One form of the design is illustrated in Figures 1 to 4 (R. 7) and another form of the design is illustrated in Figures 5 to 8 (R. 9) of the drawing. There are three claims (R. 28) in the application: claim 1 directed to the design as shown in Figures 1 to 4; claim 2 directed to the design as shown in Figures 5 to 8; and claim 3 directed to the design having the common appearance as shown in Figures 1 to 8.

The Patent Office Examiner on September 29, 1955 finally rejected all claims "on the ground that a multiplicity of designs is *claimed*"* (R. 11).

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* Emphasis added throughout unless otherwise indicated.

No action was given on the merits, that is, concerning the patentable novelty of the design. Neither was there a requirement for restriction of the application to one of two independent inventions. No determination was made by the Examiner as to whether there was but one design invention or two design inventions disclosed and claimed in the application.

On appeal to the Patent Office Board of Appeals, the decision of the Examiner was affirmed by the Board (R. 20-24).

On appeal to the United States Court of Patent Appeals, the decision of the Board of Appeals was affirmed in the Court's decision of May 22, 1959 (Appendix A). The Court said:

> "No references have been cited and there is no issue as to whether appellant's designs involve patentable invention.
>
> "The exact ground on which the claims were rejected is somewhat obscure. * * *
>
> * * * * *
>
> "The board in its opinion stated the ground of rejection as being 'that a multiplicity of designs are claimed' and limited its discussion to the *disclosure* of two embodiments of the design, no express statement being made that plural *claiming* was bad per se. However, since the examiner raised the issue of multiple claiming as well as multiple disclosure, and since the board entered a general affirmance of the examiner's decision, the former issue is before this court as well as the latter." (Emphasis by the Court.) (Appendix A, pp. 15, 16.)

The Court below pointed out that the decision was made without regard to the kind or degree of differences between the two embodiments disclosed, by the observation:

"In rejecting the claims as being based on a multiplicity of designs, the Patent Office tribunals did not rely in any way on the extent or nature of the differences between the two embodiments shown in appellant's application, * * *" (Appendix A, p. 16).

Insofar as the rejection by the Patent Office was based on a multiplicity of disclosures (the two forms of design for a floor waxer), the Court below disagreed with the Patent Office and ruled that ground of rejection improper, the Court stating:

"For the reasons given, we are of the opinion that it cannot be stated as an invariable rule that a design application cannot disclose more than one embodiment of the design. Whether such disclosure is improper must depend upon the particular circumstances of the individual case involved, and a blanket rejection on the ground of 'multiplicity', without considering such circumstances, is not proper. On this particular point we are unable to agree with the board.

"It remains to be determined whether, regardless of disclosure, the rejection can be sustained on the ground that a single claim only is permissible in a design application." (Appendix A, p. 21.)

The Court then went on to hold on the basis of Patent Office Rule 153 that more than one claim was not permissible, noting (Appendix A, p. 22) that, "Patent Office Rule 153, relating to design cases, provides that 'More than one claim is not permitted.' "

The Court cited the long-established practice in the Patent Office in support of Rule 153. This custom or practice was said by the Court to be first established by an early decision of the Commissioner of Patents as noted by the Court, as follows:

"Under such circumstances, as was pointed out by the Commissioner in *ex parte Wiessner*, 1898 C. D. 236, 85 O. G. 937, no useful purpose could be served by the inclusion of more than one claim in a design application or patent.

"Since the *Wiessner* decision, it appears to have been the uniform practice of the Patent Office to allow only one claim in a design patent." (Appendix A, p. 23.)

Patent Office Rule 153 (Appendix D), directed to the requirements of applications for design patents, specifies that in design cases: "More than one claim is neither required nor permitted." There is no citation or footnote associated with this rule of any statutory authority in support of the rule.

The Court below conceived that, although a design patent application may disclose or show a plurality of embodiments or modifications of design invention, only a single claim should be permitted in design patents, as illustrated by its statement:

"We find no sound reason for disturbing the long-standing practice of the Patent Office, embodied in Rule 153, which limits design applications to a single claim.

"The decision of the Board of Appeals must, therefore, be affirmed insofar as it is predicated on the ground that plural claims cannot be allowed" (Appendix A, p. 24.)

The effect of the decision of the Court of Customs and Patent Appeals was to overrule as without legal basis the long-standing practice of the Patent Office which limited the *disclosure* in design patent applications to a single embodiment or modification of design invention, but to permit to remain in force the long-standing practice of the Patent Office, as expressed in Patent Office Rule 153, to

limit design patent applications in *all* cases (regardless of the number of modifications and regardless of the degree and kind of distinctions between them) to but a *single* claim.

REASONS FOR GRANTING THE WRIT.

1. The decision below has, without legal basis, rendered null and void the mandate of 35 U. S. C. 171 (Appendix C, p. 26), which states that "The provisions of this title *shall apply* to patents for designs, except* as otherwise provided," in the following respects:

(a) The decision has rendered ineffective and inapplicable to *all* design cases the provisions of 35 U. S. C. 121 (Appendix C, p. 25), because that statute by its own words is operative only

> "If two or more independent and distinct inventions are *claimed* in one application * * *,"

and because division and restriction under that statute inherently and in practice involves a division and restriction as between *claimed* inventions.

(b) The decision has rendered ineffective and inapplicable to *all* design cases the provisions of 35 U. S. C. 112 (Appendix C, p. 25), because that statute by its own words requires and permits:

> "The specification shall conclude with *one or more claims* particularly pointing out and distinctly claiming the subject matter which the *applicant regards* as his invention,"

and which statute entitles all applicants to submit to the Patent Office for its full consideration upon the facts existing in each case such claims (one or more)

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* Some statutory exceptions are the differing terms of duration for design patents (35 U. S. C. 173) and the requirement for an ornamental appearance rather than usefulness (35 U. S. C. 171), none of which are pertinent here.

as an applicant regards proper "for particularly pointing out and distinctly claiming * * * his invention," under the general limitation of Patent Office Rule 75 (Appendix D, p. 27) that "(b) More than one claim may be presented provided *they* differ substantially from each other and are not unduly multiplied."

2. The decision has wrongfully deprived this design patent applicant of substantial legal rights available to non-design patent applicants, without statutory basis for the distinction in treatment, in the following respects:

(a) In non-design cases, an applicant who has had his application subjected to a holding of the Patent Office under the authority of 35 U. S. C. 121 (Appendix C, p. 25) that "two or more independent and distinct inventions" are *claimed* therein, and who in compliance therewith restricts the application to one claimed invention, and files a divisional application on the other claimed invention, has the *statutory protection* that the patents issuing under each of the two applications shall not be used as references against each other, the statutory protection being found in said 35 U. S. C. 121, as follows:

> "A patent issuing on an application with respect to which a requirement for restriction under this section has been made, or on an application filed as a result of such requirement, *shall not be used* as a reference either in the Patent Office or in the courts against a divisional application or against the original application or any patent issues on either of them, if the divisional application is filed before the issuance of the patent on the other application. * * *"

which statutory protection is denied to all design applicants because of the Court's decision giving ap-

proval to the practice of limiting all design applicants to a single claim.

(b) In non-design cases an applicant who discloses, for example, two species of his invention (as the applicant in this case disclosed two modifications) is entitled under the practice governing all non-design cases to obtain a patent which includes a claim covering one species only, a claim covering the other species only, and a generic claim covering both species (assuming that the claims would "differ substantially" under the criterion of Patent Office Rule 75, Appendix D, p. 27), and thereafter in a suit for infringement of the non-design patent, if the generic claim or one of the species claims is invalidated by the prior art, the patentee is still left with the protection afforded by the remaining non-invalidated claim, but which residual protection is denied to a design patentee, (regardless of the differences in kind and degree between different embodiments or modifications of his design invention disclosed) because of the absolute prohibition against plural claims in all design cases under the long-standing practice of the Patent Office left in effect by the decision below.

3. The decision below deprives the Patent Office of an authority and means of orderly procedure granted to the Patent Office by the statutes (with accompanying provisions for protection of applicants) and hence makes for confusion and lack of uniformity in procedure in the handling of design patent applications by the Patent Office in the following respects:

(a) Upon a design patent applicant *disclosing* a plurality of embodiments or modifications (as now authorized under the decision below), but with a *single* claim, such as "The ornamental design for a

floor waxer substantially as shown," as suggested by the decision below (Appendix A, p. 23), the Patent Office has *no authority or basis* for requiring the design applicant to restrict the application to one of the disclosed embodiments or modifications, *regardless* of how differing in kind and degree those disclosed embodiments or modifications may be in any case, because said 35 U. S. C. 121 (Appendix C, p. 25). applies only where "two or more independent and distinct inventions are *claimed* in one application," and hence is inapplicable to a design patent application disclosing a plurality of modifications or embodiments of design invention but presenting but a single claim to everything shown.

(b) Upon a design patent applicant *disclosing* a plurality of embodiments or modifications (as now authorized under the decision below), but having (assumed for purposes of argument) only inconsequential and unsubstantial differences between the embodiments or modifications shown, but with a *single* claim, such as "The ornamental design for a floor waxer substantially as shown" as suggested by the decision below (Appendix A, p. 23), the Patent Office has no authority or basis for holding that the plurality of embodiments or modifications do not "differ substantially from each other" because the criterion of Patent Office Rule 75 (Appendix D, p. 27), administering the provisions of 35 U. S. C. 112 (Appendix C, p. 25), is only that multiple *claims* "differ substantially from each other," and there is no other basis under the law for ruling out inconsequential and unsubstantial differences.

(c) Upon the Patent Office being called upon to rule upon "units of invention," either to rule (1) upon whether there are "two or more independent

and distinct inventions" or (2) upon whether the invention disclosures "differ substantially from each other," in any case, either design or non-design applications, the only "units of invention" recognized by the statutes are claims, and it is only "units of invention" in the form of *claims* which are capable of being handled in ruling upon such questions in procedure in the Patent Office.

4. The decision below in sustaining Patent Office Rule 153 on the basis of a "long-standing practice" in the Patent Office is without legal support and is contrary to authority in the following respects:

(a) No statute was or could be cited in support of Rule 153, and there was ignored the statutory instruction of 35 U. S. C. 171 (Appendix C, p. 26) that "The provision of this title *shall apply* to patents for design, except as otherwise provided."

(b) The only "authority" cited by the Court below (Appendix A, p. 23) in support of its decision approving the rule allowing but a single claim in all design cases, *other than* decisions from within the Patent Office itself, was the earlier decision of the Court below in the case of *In re Eppinger*, 25 CCPA 843, 94 F. 2nd 401, 36 USPQ 325, containing *dicta* which seemed to approve the single-claim rule of the Patent Office upon the "authority" of a decision of the Patent Office itself and the then current Patent Office rules, in the following quotation from the *In re Eppinger* decision:

"* * * In passing it may be proper to say that appellant's specification and form of claims is quite unusual. It seems to us that the suggestion of the examiner that appellant was entitled to but one

claim, in substantially the form as was suggested, was proper. *Ex parte Hopkins, Jr.* 1923 C. D. 105. See Rules of Practice in the United States Patent Office Nos. 81, 82, and 84; also form of design application prescribed by the rules." (Appendix A, p. 23.)

However, in the *Eppinger* case, there had been disclosed but a *single* embodiment of the invention and so the question of a plurality of claims to cover a plurality of embodiments did not arise. The issue present in the instant case was not there presented. Further, that application had been denied for want of patentable invention over the prior art and this holding was affirmed, making unnecessary the Court's comment on the single claim rule.

There is therefore no controlling authority to support the decision below approving the single-claim rule on the basis of "long-standing practice of the Patent Office" in *all* design cases, including applications disclosing a plurality of embodiments of the design invention.

5. The decision below is in direct conflict with the decision of this Court in the 1904 case of *U. S. ex rel. Steinmetz v. Allen*, 192 U. S. 543; 24 S. Ct. 416. In the *Steinmetz* case, the Patent Office had a "long established practice" and a then current Rule 41* expressing that long

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* Then current Patent Office Rule 41 (in its present form is Rule 141) provided:

"Two or more independent inventions cannot be claimed in one application; but where several distinct inventions are dependent upon each other and mutually contribute to produce a single result, they may be claimed in one application.

* * * * *

"Claims for a machine and the process in the performance of which the machine is used *must be presented in separate applications.*"

established practice which arbitrarily prohibited inclusion in one application claims on a process and claims on apparatus regardless of how closely the process and apparatus were factually related or associated in any particular application. In rejecting the Steinmetz application, the Patent Office had relied upon that "long established practice" and the then current Rule 41 in defense of its position. This Court was not then persuaded that age of an error was a justification for perpetuating the error and held the "long established practice" to be wrong and the rule of practice to be invalid. This Court in overruling the Patent Office in the *Steinmetz* case stated:

> "Can it be said that a process and an apparatus are inevitably so independent as never to be 'connected in their design and operation'? They may be completely independent. *Cochrane v. Deener*, 94 U. S. 780. But they may be related. They may approach each other so nearly that it will be difficult to distinguish the process from the function of the apparatus. In such case, the apparatus would be the dominant thing. But the dominance may be reversed and the process carry an exclusive right, no matter what apparatus may be devised to perform it.
>
> "If there is a divergence of views between courts and the Patent Office and the divergence proceeds from a different interpretation of the statute, the views of the courts ought to prevail. If the courts, however, have only recognized and enforced the exercise of a discretion of the Patent Office, the question occurs, what is the extent of such discretion and can it be expressed and fixed in an inflexible rule such as rule 41?
>
> * * * * *
>
> "Some discretion is not unlimited discretion, and if the discretion be not unlimited it is reviewable. In other words, the statute gives the right to join inventions in one application in cases where the in-

ventions are related, and it cannot be denied by a hard and fixed rule which prevents such joinder in all cases. Such a rule is not the exercise of discretion; it is a determination not to hear. No inventor can reach the point of invoking the discretion of the Patent Office. He is notified in advance that he will not be heard, no matter what he might be able to show. His right is denied, therefore, not regulated. Such is the necessary effect of rule 41, as amended.

"Without that rule the action of the Patent Office can be accommodated to the character of inventions, and discretion can be exercised, and when exercised, we may say in passing, except in cases of clear abuse, the courts will not review it. But the rule as amended, as we have said, precludes the exercise of any judgment and compels the separation of claims for a process and claims for its apparatus, however related or connected they may be. And the right denied is substantial.

* * * * *

"The Patent Office has not been consistent in its views in regard to the division of inventions. At times convenience of administration has seemed to be of greatest concern; at other times more anxiety has been shown for the rights of inventors. The policy of the office has been denominated that of 'battledore and shuttlecock,' and rule 41 as it now exists was enacted to give simplicity and uniformity to the practice of the office. Its enactment was attempted to be justified by the assumption that the patent laws gave to the office a discretion to permit or deny a joinder of inventions. But, as we have already said, to establish a rule applicable to all cases is not to exercise discretion. Such a rule ignores the differences which invoke discretion, and which can alone justify its exercise, and we are of the opinion therefore that rule 41 is an invalid regulation."

U. S. ex rel. Steinmetz v. Allen, 192 U. S. 543, 559, 560, 561, 563 (1904).

From the above it is demonstrated that the holding in the decision below is diametrically opposed to the law enunciated by this Court in the *Steinmetz* case. Just as the "long established practice" was wrong and unauthorized in that case, so, too, is the "long-standing practice" wrong and unauthorized in the instant case. Just as then current Rule 41 was then held invalid, so, too, Patent Office Rule 153 should be held invalid here.

CONCLUSION.

The petition for a writ of certiorari should be granted for the foregoing reasons.

Respectfully submitted,

BRUCE B. KROST,

Attorney for Petitioner.

December, 1959.

APPENDIX A.

OPINION OF THE COURT OF CUSTOMS AND PATENT APPEALS.

WORLEY, *Chief Judge*.

This is an appeal from the decision of the Board of Appeals of the United States Patent Office affirming the Primary Examiner's rejection of the three claims of appellant's application for a patent on a design for a floor waxer. The appealed claims are as follows:

> 1. The ornamental design for a Floor Waxer substantially as shown in Figures 1 to 4, inclusive.
>
> 2. The ornamental design for a Floor Waxer substantially as shown in Figures 5 to 8, inclusive.
>
> 3. The ornamental design for a Floor Waxer having the common appearance substantially as shown in Figures 1 to 8, inclusive.

Appellant's application discloses designs of two floor waxers of generally similar but specifically different appearance, one being shown in Figures 1 to 4 and the other in Figures 5 to 8.

No references have been cited and there is no issue as to whether appellant's designs involve patentable invention.

The exact ground on which the claims were rejected is somewhat obscure. In his final rejection, the examiner made the following statement:

> It is again noted that the application contains three claims which is not permissible in a design application. See Rule 153 of the Rules of Practice.
>
> The claims are therefore again and FINALLY rejected on the ground that a multiplicity of designs is claimed.

In the examiner's answer to the appeal to the board, it is said that:

> The examiner in the case has finally rejected the claims since the application does not comply with the statute as now interpreted, in that it includes more than a single claim and is directed to more than a single article. * * *
>
> The final rejection on the ground that a multiplicity of designs is claimed is deemed proper and in order.

The board in its opinion stated the ground of rejection as being "that a multiplicity of designs are claimed" and limited its discussion to the *disclosure* of two embodiments of the design, no express statement being made that plural *claiming* was bad per se. However, since the examiner raised the issue of multiple claiming as well as multiple disclosure, and since the board entered a general affirmance of the examiner's decision, the former issue is before this Court as well as the latter. *In re Wagenhorst*, 20 C. C. P. A. 991, 64 F. 2d 780, 17 U. S. P. Q. 330; *In re Wahl*, 30 C. C. P. A. 719, 132 F. 2d 323, 56 U. S. P. Q. 158. It is noted that appellant's eighth reason of appeal here is that "The Board of Appeals erred in holding in effect that a design application could not include more than one claim."

In rejecting the claims as being based on a multiplicity of designs, the Patent Office tribunals did not rely in any way on the extent or nature of the differences between the two embodiments shown in appellant's application, but based their rejection on the proposition that two different embodiments can never properly be illustrated in a design application. In support of that proposition it is urged that since 35 U. S. C. 171 provides for a patent on a design for "an article of manufacture," rather than a plurality of such articles, and since the total substance of a design rests in its appearance as a whole, a single patent cannot be based upon a showing of two or more different designs for an article, no matter how similar they may be.

It is not apparent that 35 U. S. C. 171, relating to design inventions, is any more limited to a single article or form of article, than is 35 U. S. C. 101, relating to inventions of other kinds. The former refers to "any new, original and ornamental design for an article of manufacture" and the latter to "any new and useful process, machine, manufacture, or composition of matter." Neither of the quoted expressions includes any plural term, and yet a plurality of specifically different processes, machines, manufactures, and compositions of matter, so long as they are embodiments of a single invention, are commonly described and claimed in a single patent. Since the language of 35 U. S. C. 101 does not preclude that practice, we see no reason why the similar language of 35 U. S. C. 171 should, per se, preclude the showing of two or more embodiments of a design invention.

In connection with its statement that the total substance of a design rests in its appearance, the board said the practice was firmly established that "design inventions cover 'an article of manufacture' in the sense presented by its appearance or physical shape rather than in the sense that the invention is a theme of decoration or a mental creation of the inventor that is only presented in the patent by way of an illustrative embodiment." If the quoted statement means that a design invention can exist only in some one specific physical embodiment, we are unable to agree with it.

It is well settled that a design patent may be infringed by articles which are specifically different from that shown in the patent, *Gorham Co. v. White*, 81 U. S. 511; *Borgfeldt & Co. v. Weiss*, 265 Fed. 268, and it has been repeatedly held that a patent will be refused on an application claiming a design which is not patentably different from, or involves the same inventive concept as, a design

claimed in a patent granted to the same inventor, even on a copending application. *In re Bigelow*, 39 C. C. P. A. 835, 194 F. 2d 550, 93 U. S. P. Q. 17; *In re Russell*, 44 C. C. P. A. 716, 239 F. 2d 387, 112 U. S. P. Q. 58, and cases there cited. It seems evident, therefore, that the inventive concept of a design is not limited to the exact article which happens to be selected for illustration in an application or patent.

While the exact issue under consideration here has not previously been before this Court, *In re William Schnell*, 18 C. C. P. A. 812, 46 F. 2d 203, 8 U. S. P. Q. 19, contains the following language clearly indicating the opinion that the disclosure of more than one specific embodiment of a design invention in a single application may be proper:

> * * * Furthermore we know of no statutory or other reason why he [a design applicant] may not be permitted to submit drawings of more than one article if his design applies to more than one article and if it seems necessary and essential to use more than one drawing in order that he may teach the manner of applying the same to different articles.
>
> * * * * *
>
> * * * If he is entitled to certain protection under the enforcement provision, why is he not entitled by some appropriate words in the claim and drawing to disclose all that he is entitled to in order that others may be warned of the probable scope of applicant's invention? See *Grant v. Raymond*, 6 Peters 218. As was said in *Ashley v. Tatum Co.*, *supra*, (186 F. 339) "the absence of such a description in the case at bar has a necessary bearing on the construction of the patent and consequently on the question of infringement."

It seems anomalous to hold that two specifically different articles may represent a single inventive concept so

far as double patenting or infringement is concerned, and yet may not be disclosed in a single application.

It appears that the instant rejection, so far as it is based on the fact that the application discloses more than one embodiment of appellant's design, raises a question of form rather than of substance. The designs of Figures 1 to 4 and 5 to 8 differ primarily in that the latter includes certain braces not present in the former. Apparently appellant could have presented a single set of drawings showing the braces in dotted lines, as "immaterial" parts, and seemingly no objection would have been made by the Patent Office, although the substance of the disclosure would have been substantially what it is now. See Sec. 1503.01 M. P. E. P.

It is argued in the brief for the Commissioner that the rejection of the appealed claims was in accordance with the long standing practice of the Patent Office and, therefore, should not be set aside. So far as the limitation of the disclosure to one specific embodiment is concerned, no such settled practice has been shown. With regard to a contention by the Solicitor of the Patent Office in the *Schnell* case that the uniform practice of the Patent Office had, for many years, required "that design patents should be for a single article of manufacture" this Court said:

> * * * We may dispose of this contention of the solicitor, at this point, by saying that in view of rulings in certain cases hereinafter referred to, no such uniform practice in the Patent Office in this respect is shown to have prevailed for a very long period of time. * * *

Later in the opinion cases were cited to support the quoted statement. No Patent Office decisions of a date subsequent to that in the *Schnell* case have been cited here, and accordingly, there is no more evidence as to any long standing practice now than there was then.

It is true that the Patent Office has, on some occasions, held that only one species of a design invention may be disclosed in an application. In one such case, *Ex parte Kahn*, 1905 C. D. 212, 116 O. G. 2008, the Commissioner quoted, with approval, the following statement from *Feder v. Poyet*, 1899 C. D. 218, 89 O. G. 1343:

> * * * If an inventor has a generic design capable of modification—that is, a design made up of a small number of simple elements to which other elements may be added without modification of the essential elements—he should, in order to secure protection for the generic design, show the design in his application in its simplest form. He must show the genus stripped of additions. * * *

The quoted language seems to us to be unrealistic since it requires the inventor to decide, at his peril, which features of his design are "essential," and to limit his application to them, instead of showing the actual design in its final form.

It is also to be noted that the difference between embodiments of a design invention may take the form of modification of the shape of one or more elements rather than an addition of elements. In such a case it cannot properly be said that one embodiment is generic and another specific.

Another theory on which the Patent Office has refused to allow the disclosure of more than one embodiment of a design invention is set forth in the following quotation from the decision of the Commissioner in *Ex parte Hill & Renner*, 1898 C. D. 38, 82 O. G. 1988:

> If an applicant be of the opinion that two or more shapes are one and the same design, he should show only one such shape in his application, leaving the courts to determine whether the other shapes are the same design as that shown in his patent and whether

they infringe such shape or design. (*Ex parte Petzold*, C. D., 1891, 97; 55 O. G., 1652; and *ex parte Hess and Hess*, C. D., 1891, 142; 56 O. G., 1334.) If the different shapes are different designs, different patents should be obtained to cover them.

As above indicated, when similar designs or embodiments are presented by an inventor in separate applications, the Patent Office does not leave the determination as to whether they are distinct inventions to the courts, but, if it finds only one inventive concept to be involved, allows a patent on one application and rejects the others on the ground of double patenting. It is not apparent, therefore, why that office should refuse to undertake a similar determination when different embodiments are presented in a single application. No doubt, as was said by the Commissioner in *Ex parte Lunken*, 1896 C. D. 22, 76 O. G. 785, "it would be convenient for the office to dispose of the question summarily by requiring but one invariable form to be shown and patented" but as was further, and we think correctly, pointed out by the Commissioner in that case, such convenience cannot take precedence over the rights of applicants.

For the reasons given, we are of the opinion that it cannot be stated as an invariable rule that a design application cannot disclose more than one embodiment of the design. Whether such disclosure is improper must depend upon the particular circumstances of the individual case involved, and a blanket rejection on the ground of "multiplicity," without considering such circumstances, is not proper. On this particular point we are unable to agree with the board.

It remains to be determined whether, regardless of disclosure, the rejection can be sustained on the ground that a single claim only is permissible in a design application.

Patent Office Rule 153, relating to design cases, provides that "More than one claim is not permitted." As was pointed out in *United States, ex rel. Steinmetz v. Allen, Commissioner of Patents*, 104 O. G., 853, 1903 C. D. 578, 22 App. D. C. 56, the rules of the Patent Office have the force and effect of law unless they are inconsistent with statutory provisions. In that case, the court said:

> If there be no such inconsistency with the express provisions of the statute the rules are valid and have the force and effect of law in all matters to which they relate. They are certainly not to be declared invalid upon any consideration of doubtful construction, but only for such conflict or inconsistency with the statute law upon the subject as shall be made plainly to appear. * * *

We are unable to find any clear conflict between Rule 153 and the applicable statutes. Title 35, section 171 of the United States Code provides that "The provisions of this title relating to patents for inventions shall apply to patents for designs, except as otherwise provided." While 35 U. S. C. 112 states that "The specification shall conclude with one or more claims," that provision does not necessarily mean that every applicant shall, as a matter of right, be entitled to present a plurality of claims regardless of the nature of the invention involved. Similarly, 35 U. S. C. 121, on which appellant relies heavily, contains no express provision that every applicant is entitled to more than one claim, but sets forth the practice which the Commissioner may follow when claims to two or more independent and distinct inventions are presented.

It has been consistently held for many years that it is the appearance of a design as a whole which is controlling in determining questions of patentability and infringement. *Gorham Company v. White*, 81 U. S. 511; *In re Schraubstadter*, 26 App. D. C. 331, 1906 C. D. 541; *In re*

Bonnell, 29 C. C. P. A. 1104, 129 F. 2d 520, 54 U. S. P. Q. 202; *In re Campbell*, 41 C. C. P. A. 896, 212 F. 2d 606, 101 U. S. P. Q. 406; and *In re Russell*, 44 C. C. P. A. 716, 239 F. 2d 387, 112 U. S. P. Q. 58. Under such circumstances, as was pointed out by the Commissioner in *ex parte Wiessner*, 1898 C. D. 236, 85 O. G. 937, no useful purpose could be served by the inclusion of more than one claim in a design application or patent.

Since the *Wiessner* decision, it appears to have been the uniform practice of the Patent Office to allow only one claim in a design patent. See Symons, *The Law of Patents for Designs* (1914), page 88; *Walker on Patents*, Deller's Edition (1937) page 414. That practice was, in effect, approved by this Court in *In re Eppinger*, 25 C. C. P. A. 843, 94 F. 2d 401, 36 U. S. P. Q. 325, where the court said:

> * * * In passing it may be proper to say that appellant's specification and form of claims is quite unusual. It seems to us that the suggestion of the examiner that appellant was entitled to but one claim, in substantially the form as was suggested, was proper. *Ex parte Hopkins, Jr.* 1923 C. D. 105. See Rules of Practice in the United States Patent Office Nos. 81, 82, and 84; also form of design application prescribed by the rules.

The fact that it may be permissible, in a proper case, to illustrate more than one embodiment of a design invention does not require or justify more than one claim. Such embodiments can be presented only if they involve a single inventive concept; and such a concept can be protected by a single claim. A single claim to "The ornamental design for a floor waxer substantially as shown" would afford exactly the same degree of protection to appellant in the instant case as would the three claims involved in this appeal.

A so-called generic claim, such as claim 3 of the instant application, covering the "common appearance" of two modifications, is apparently directed to some broad concept which is not illustrated. Such a claim is indefinite and has no proper place in a design application. An applicant for a design patent cannot properly illustrate two designs on the theory that they represent embodiments of a single invention and, at the same time, claim them separately as representing different inventive concepts.

We find no sound reason for disturbing the long-standing practice of the Patent Office, embodied in Rule 153, which limits design applications to a single claim.

The decision of the Board of Appeals must, therefore, be affirmed insofar as it is predicated on the ground that plural claims cannot be allowed.

AFFIRMED.

Johnson, J., Retired, concurs in result.

Johnson, J., Retired, recalled to participate.

APPENDIX B.

JUDGMENT OF THE COURT OF CUSTOMS AND PATENT APPEALS.

Said appeal having heretofore been brought on to be heard before the court and due consideration thereon having been had, it is—

ORDERED that the decision of the Board of Appeals be, and the same is hereby, affirmed.

APPENDIX C.

PERTINENT STATUTES.

35 U. S. C. 112—Specification

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

An element in a claim for a combination may be expressed as a means or step performing a specified function without the recital of structure, material, or acts in support thereof, and such claim shall be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof.

35 U. S. C. 121—Divisional applications

If two or more independent and distinct inventions are claimed in one application, the Commissioner may require the application to be restricted to one of the inventions. If the other invention is made the subject of a divisional application which complies with the requirements of section 120 of this title it shall be entitled to the benefit of the filing date of the original application. A patent issuing on an application with respect to which a requirement for restriction under this section has been made, or on an application filed as a result of such a requirement, shall not be used as a reference either in the Patent Office

or in the courts against a divisional application or against the original application or any patent issued on either of them, if the divisional application is filed before the issuance of the patent on the other application. If a divisional application is directed solely to subject matter described and claimed in the original application as filed, the Commissioner may dispense with signing and execution by the inventor. The validity of a patent shall not be questioned for failure of the Commissioner to require the application to be restricted to one invention.

35 U. S. C. 171—Patents for designs

Whoever invents any new, original and ornamental design for an article of manufacture may obtain a patent therefor, subject to the conditions and requirements of this title.

The provisions of this title relating to patents for inventions shall apply to patents for designs, except as otherwise provided.

35 U. S. C. 173—Term of design patent

Patents for designs may be granted for the term of three years and six months, or for seven years, or for fourteen years, as the applicant, in his application, elects.

APPENDIX D.

PERTINENT PATENT OFFICE RULES.

75. *Claim.* (a) The specification must conclude with a claim particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention or discovery.

(b) More than one claim may be presented, provided they differ substantially from each other and are not unduly multiplied.

(c) When more than one claim is presented, they may be placed in dependent form in which a claim may refer back to and further restrict a single preceding claim.

(d) The claim or claims must conform to the invention as set forth in the remainder of the specification and the terms and phrases used in the claims must find clear support or antecedent basis in the description so that the meaning of the terms in the claims may be ascertainable by reference to the description.

See rules 141 to 147 as to claiming different inventions in one application.

153. *Title, description and claim, oath.* The title of the design must designate the particular article. No description, other than a reference to the drawing, is ordinarily required. The claim shall be in formal terms to the ornamental design for the article (specifying name) as shown, or as shown and described. More than one claim is neither required nor permitted.

The oath required of the applicant must comply with rule 65 except that the period of twelve months specified therein with respect to foreign applications is six months in the case of designs.

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No. 622

In the Supreme Court of the United States

OCTOBER TERM, 1959

DON H. RUBENFIELD, PETITIONER

v.

ROBERT C. WATSON, COMMISSIONER OF PATENTS

ON PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF CUSTOMS AND PATENT APPEALS

BRIEF FOR THE RESPONDENT IN OPPOSITION

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ON PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF CUSTOMS AND PATENT APPEALS

BRIEF FOR THE RESPONDENT IN OPPOSITION

OPINION BELOW

The opinion of the United States Court of Customs and Patent Appeals (Pet. App. 15–24) is reported at 270 F. 2d 391.

JURISDICTION

The judgment of the United States Court of Customs and Patent Appeals was entered on May 22, 1959. A timely motion for rehearing was denied on October 6, 1959 (Pet. 1). The petition for a writ of certiorari was filed on December 31, 1959. The jurisdiction of this Court is invoked under 28 U.S.C. 1256.[1]

[1] We have previously argued to the Court that it does not have jurisdiction to review a decision of the Court of Customs and Patent Appeals affirming a refusal of the Board of Appeals

QUESTION PRESENTED

Whether Patent Office Rule 153, which requires that an application for a design patent contain only one claim, is invalid.[2]

STATUTES AND RULES INVOLVED

The pertinent provisions of Title 35, United States Code, and the Patent Office Rules of Practice, 37 C.F.R. 1.1, *et seq.*, are set out in the Appendix, *infra*, pp. 15–17.

STATEMENT

Petitioner, on October 29, 1954, applied for a patent on a design for a floor waxer (R. 3–9). The application contained three claims for patents, and drawings showing eight figures (R. 7–9). The first claim was for a patent on "The ornamental design for a Floor Waxer substantially as shown in Figures 1 to 4 inclusive", while the second claim was for "The ornamental design for a Floor Waxer substantially as shown in Figures 5 to 8 inclusive" (R. 20). The only difference between the floor waxer shown in figures 1 through 4, and that depicted in figures 5 through 8, was that the latter had two braces, apparently supporting the handle, while the former did not. (R. 7–9, Pet. App. 19.) The third claim in petitioner's application sought a patent on "The ornamental design for a Floor Waxer having the common appear-

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of the Patent Office to grant a patent. See, *e.g.*, the brief for the respondent in opposition, *Ducci* v. *Commissioner of Patents*, No. 603, Oct. Term, 1955, pp. 4–7; and the brief for the respondent in opposition in *Tatincloux* v. *Commissioner of Patents*, No. 734, Oct. Term, 1955. We renew and reserve that jurisdictional contention in this case.

[2] See footnote 1, *supra*, p. 1.

ance substantially as shown in Figures 1 to 8, inclusive" (R. 20). The Patent Office Examiner rejected the application on the ground that it presented a multiplicity of claims for patents, in violation of Patent Office Rule 153 (37 C.F.R. 1.53, *infra*, p. 17) (R. 11). This rejection was sustained by the Supervisory Examiner (R. 13–16), and petitioner took an appeal to the Patent Office Board of Appeals, which affirmed the Examiner's decision (R. 19–24).

Petitioner next sought review in the United States Court of Customs and Patent Appeals (R. 25–27). That court affirmed the Board's decision, on the ground that petitioner's application was defective in that it contained more than one patent claim, in violation of Patent Office Rule 153, *infra*, p. 17. (Pet. App. 22–24.) The court's opinion (Pet. App. 15–24), filed on May 22, 1959, makes it clear that the multiplicity of claims in petitioner's application was the sole ground for approving its rejection. The court expressed its sharp disapproval of the Board's alternative ruling that an application for a design patent must always be rejected if its drawings show two or more different articles embodying a single design for which a single patent is sought (Pet. App. 16–21). The court stressed that the concept of a design for patent purposes "is not limited to the exact article which happens to be selected for illustration in an application." In view of the fact that a patentable design is not limited to one article embodying it, the court reasoned, an applicant should be permitted to submit drawings of more than one article

in order to "teach the manner of applying [his design] to different articles * * * [in order to] disclose all that he is entitled to * * * that others may be warned of the probable scope of [his] invention" (Pet. App. 18). The court concluded that "it cannot be stated as an invariable rule that a design application cannot disclose more than one embodiment of the design" (Pet. App. 21), and rejected any such rule.

However, the court rejected petitioner's contention that Patent Office Rule 153, providing that "more than one claim is not permitted", is in conflict with the applicable statutes and therefore invalid, and sustained the Board's decision on the ground of multiplicity of claims (Pet. App. 22). The court's ruling was based on its holding that "The fact that it may be permissible, in a proper case, to illustrate more than one embodiment of a design invention does not require or justify more than one claim. Such embodiments can be presented only if they involve a single inventive concept; and such a concept can be protected by a single claim" (Pet. App. 23).

ARGUMENT

Examination of the Patent Office practice respecting multiplicity of claims shows that Rule 153, prohibiting applicants for design patents from using more than one claim in an application, is entirely reasonable. Moreover, contrary to petitioner's assertions, Congress did not intend to disturb this practice when it enacted Title 35 in 1952, and the decision below is not in conflict with *United States ex rel. Steinmetz* v. *Allen*, 192 U.S. 543. Nor is the case of any

general importance, especially since the decision below, in correcting the Patent Office practice of permitting a design applicant to show only one embodiment of his design in his drawings, insures full protection to the rights of design applicants.

1. Under Section 101 of Title 35 of the United States Code, enacted in 1952, the Patent Office is directed to issue an invention patent to "[w]hoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof * * *." Early in its administration of the forerunners of this provision, the Patent Office required that a single application for an invention patent contain in its specification claims for only one invention. The reasons for this requirement were that it increased the amount collected in application fees (*Hogg* v. *Emerson*, 6 How. 437, 483), avoided the inequity of permitting an inventor to obtain more than one patent after paying only one application fee (*Ex parte Yale*, 1869 C.D. 110), and, most importantly, facilitated the administrative processing of patent applications (*ibid.*).[1] The courts, in order to promote clarity and

[1] See also footnote 1, *supra*, p. 1.

[2] See Seidman and Horwitz, *Patent Office Rules and Practice* (1959), § 141.2, pp. 521–522, in which it is stated that a vital reason for the requirement that only one invention be stated in one application, except where the inventions are dependent and related, is to be found in "* * * the classification of the various subjects of invention, and the assignment of the different classes to different Examiners. This division of labor is absolutely essential to the prompt and thorough examination of applications. It is adopted to facilitate the transaction of the public business, and the inventor himself is directly and imme-

certainty in patents and applications, early declared this requirement to be consistent with the former version of 35 U.S.C. 101.[5] See, *e.g.*, *United States ex rel. Steinmetz* v. *Allen*, 192 U.S. 543, 557–558; *Wyeth* v. *Stone*, 1 Storey 273.

However, it was also recognized that the validity of an invention patent, and the scope of the monopoly granted under it, must be determined solely by what the inventor claimed in his application. See, *e.g.*, *Western Electric Manufacturing Co.* v. *Ansonia Brass & Copper Co.*, 114 U.S. 447; *Grier* v. *Wilt*, 120 U.S. 412; *Ajello* v. *Pan-American Airways Corp.* 128 F. 2d 196 (C.A. 2). It therefore became the practice that an applicant was permitted to include several claims, each one expressing what he intended to patent in language different from the others, so that he could be sure to cover, in at least one claim, all the patentable elements of his invention, without using language so broad that his patent would be invalid for covering unpatentable elements. See, *e.g.*, *A. B. Dick Co.* v. *Underwood Typewriter Co.*, 246 Fed. 309 (S.D.N.Y.), affirmed, 252 Fed. 990 (C.A. 2); *Parke-Davis & Co.* v. *H. K. Mulford Co.*, 189 Fed. 95 (S.D.N.Y.), affirmed, 196 Fed. 496 (C.A. 2).

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diately benefited by a strict adherence to it. Any union of inventions in one patent that would seriously impair this classification ought not to be permitted. Besides the delay and increased difficulty in making the examination, if the patent covers devices which enter into two classes, the drawing, which is single, must be deposited in the portfolio of the one class and be wanting in the portfolio of the other. It may thus be overlooked in the examination, of the next case."

[5] In the *Parke-Davis* case, Judge Learned Hand, then a district judge, said, 189 Fed. at 102–103: "* * * the only valid

The desirability of allowing multiple claims in applications for inventions is recognized in Patent Office Rule 75, which declares that, in invention patents, more than one claim may be presented, provided they differ substantially from one another and are not unduly multiplied, 37 C.F.R. 1.75. In recognition of the extra administrative work required when multiple claims are presented in an application, 35 U.S.C. 41 specifies that, except for design cases, the application fee should be $30 and $1 for each claim in excess of twenty.[6]

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objection to multiplication of claims is when it appears that the patentee is trying deceitfully to go beyond the fair scope of his invention. * * * No one can in advance know how far anticipations will go or how little in the end his patent will cover. There is nothing improper, so far as I can see, in first putting your claims as broadly as in good faith you can, and then, ex abundanti cautela, following them successively with narrower claims designed to protect you against possible anticipations of which you are not yet aware. Indeed, the very case upon which the defendant relies (*Matheson* v. *Campbell*, 78 Fed. 910, 917, 24 C.C.A. 384) shows the necessity of claims as broad as one can honestly support. If any one of the specified differentia of the claim is missing, the defendant's product does not infringe; if any anticipation includes all the differentia, the claim is bad. To pass between this Scylla and Charybdis, I think a patentee may fairly be entitled to bend sails upon many yards."

[6] In addition to the rule that an inventor may, when necessary for his full protection, express his single invention in more than one claim, an exception developed to the general rule that only one patent may be applied for in one application. In *United States ex rel. Steinmetz* v. *Allen*, 192 U.S. 543, it was held that, notwithstanding the general rule, inventions which are related may be joined in one application. *Steinmetz* involved an attempt to obtain separate patents on a process for measuring electric current and the apparatus, or meter, for putting the process into operation. Then Patent Office Rule 41 provided, *inter alia*, that "Claims for a machine and the process in the

2. As we have just shown, *supra*, pp. 5–7, an applicant for an *invention* patent is usually permitted to use several claims to express what he seeks to patent. The practice is quite different in *design* cases. Since 1898 the Commissioner of Patents has required design patent applicants to include only one claim in each application. *Ex parte Wiessner*, 1898 C.D. 236, 85 O.G. 937. The reason for this difference in practice is easily seen in the distinctions between invention and design patents.

An invention patent is granted for a "new and useful" process, machine, manufacture, or composition of matter, or an improvement thereof. 35 U.S.C. 101, *supra*, p. 5. Words are the best means of explaining what constitutes the novelty or originality in such an article or process, and it is not surprising that the words of a claim for an invention are determinative of its scope and validity. However, in an application for a patent on a "new, original and ornamental design for an article of manufacture" (the statutory definition of a patentable design, 35 U.S.C. 171),[7] one

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performance of which the machine is used must be presented in separate applications." This Court held, however, that claims for related inventions may be joined in one application. The Court recognized that the determination of whether two inventions are related should normally be left to the discretion of the Commissioner of Patents. Since the invention of a machine and its process are at least sometimes related, the Court held that the Commissioner could not refuse to exercise his discretion by providing by rule that a machine and its process may not be joined in one application.

[7] The Patent Act of 1842, 5 Stat. 543, the original provision for design patents, declared that patents should be awarded on "new and original" designs. The provision that the design

picture is worth a thousand words. For it is the visual impression conveyed by a design which determines questions of patentability and of infringement. See *Gorham Company* v. *White*, 14 Wall. 511, 525–527; *Pelouze Scale & Mfg. Co.* v. *American Cutlery Co.*, 102 Fed. 916, 918; *In re Schraubstadter*, 26 App. D.C. 331.

Since it is the effect on the eye, rather than the language describing this effect, which is all-important in design patents, Patent Office Rule 152 requires that all applications for design patents include drawings, while drawings are required in invention applications only "whenever the nature of the case admits" (Patent Office Rule 81, 37 C.F.R. 1.81; see 35 U.S.C. 113).[8] Additionally, because verbal descriptions of the design would probably confuse readers as to what the design actually is—the most expertly written verbal description of a design would give no two people the same idea of the visual sensation conveyed by the design—the Patent Office normally permits no description in the specification of a design patent

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must also be "ornamental" was added by the Patent Act of May 1902, 32 Stat. 193.

[8] Where a drawing is included in an application for an invention patent, it has uniformly been held that the words of the claim, not the drawing, govern the validity and scope of the patent. See, *e.g.*, *Permo Inc.* v. *Hudson-Ross, Inc.*, 179 F. 2d 386 (C.A. 7); *Hazeltine Research* v. *General Motors Corp.*, 171 F. 2d 680 (C.A. 6); *Allen* v. *Radio Corp. of America*, 47 F. Supp. 244 (D. Del.); *Leonard* v. *Horton*, 40 App. D.C. 22; *Carson* v. *Anaconda Copper Mining Co.*, 26 F. 2d 651 (C.A. 9), certiorari denied, 278 U.S. 635; *Thompson* v. *Dicke*, 110 F. 2d 98, 27 C.C.P.A. (Patents) 931; *Suczek* v. *General Motors Corp.*, 132 F. 2d 371 (C.A. 6).

application, Patent Office Rule 153, 37 C.F.R. 1.153.[9] The Rules also set out that, ordinarily, the claim in a design application should merely state the name of the article for which the design is intended, and refer to the drawings where the design is depicted. A typical example, then, of a design claim in the correct form is that which the Court of Customs and Patent Appeals suggested as proper for the petitioner's design: simply a claim for "The ornamental design for a floor waxer substantially as shown" (Pet. App. 23).

Since the function of the claim in the design patent is merely to refer the reader to the drawings, the necessity of permitting an inventor to express his invention in more than one claim, recognized in invention patents where the words of the claims are all important, does not exist in design patent cases.[10] This is especially true now that the Court of Customs and Patent Appeals has in this very case corrected the practice, followed from time to time by the Com-

[9] In *Ex parte Cady*, 1916 C.D. 57, 232 O.G. 619, the Commissioner of Patents succinctly stated:

"As to the appearance of the design, it is improper to describe that, because no amount of language can explain how a thing looks as well as the thing itself explains how it looks."

[10] In addition to serving no useful purpose, permitting the inclusion of more than one claim would be extremely detrimental to the administration of the Patent Office. A memorandum from the Patent Office Committee on Practice and Procedure to the Commissioner of Patents, referred to at 38 J.P.O.S. (1956) 301–302, states that a proposed revision of Patent Office Rule 153 to allow multiple claims in design patents would inevitably make the examiner's job more time-consuming and thus require more personnel for the processing of design claims. See also note 4, *supra*, p. 5.

missioner of Patents,[11] of not allowing the design applicant to show more than one embodiment of his design in his drawings. The design applicant is now permitted "to bend sails upon many yards", see note 5, *supra*, p. 6, by submitting drawings showing all the articles in which he believes his design can be embodied.[12]

3. Petitioner contends that, nevertheless, Patent Office Rule 153 was rendered invalid by the enactment in 1952 of Section 171 of Title 35, governing design patents, *supra*, p. 8, which, like the original design patent statute, directs that the provisions relating to invention patents should apply to design patents, except as otherwise provided. Thus, Section 112 of Title 35, dealing with the contents of invention patent appli-

[11] See *e.g.*, *Ex parte Kahn*, 1905 C.D. 212, 116 O.G. 2008; *Ex parte Hill & Renner*, 1898 C.D. 38, 82 O.G. 1988.

[12] It also should be noted that a design applicant may not submit more than one design in one application, by use of multiple claims. As we noted above, *supra*, p. 7, the general rule for invention patents is that only one patent may be applied for in one application, but an exception is recognized in the case of related inventions. This exception, however, does not apply to design patents because two designs can never be related or dependent on each other. By its very nature, a design is an independent unit, deriving its identity and its patentability from the overall impression it creates on the eye of the observer, see p. 9, *supra*. If two articles create separate and distinct impressions on the eye of the beholder, each has its own design. If they create the same impression, they have, under the rule of *Gorham Company* v. *White*, 14 Wall. 511, *supra*, the same design. Therefore, the Patent Office has, since 1898, taken the position that relationship, for purposes of joinder of claims, does not exist in design cases. *Ex parte Wiessner*, 1898 C.D. 236, 85 O.G. 937. Contrary to petitioner's assertion (Pet. 8), there is no relationship of genus and species for design patents.

cations, is made applicable to design patent applications. The former version of Section 112, R.S. 4888, provided that the applicant should "particularly point out and distinctly claim" his invention, but in 1952 the statutory language was changed to read "[t]he specification shall conclude with one or more claims * * *." Petitioner seizes on this language and reads it to require, in all cases, including design patent cases, that multiplicity of claims be allowed. However, the words "one or more" cannot be construed to vest in all patent applicants a right to more than one claim in an application. In any event, there is no indication in the legislative history of Title 35 that Congress, in making this change in language, intended to do anything more than codify the Patent Office's existing practice of allowing only one patent to be claimed in one application, except in the case of related inventions, and of allowing multiplication of claims for one invention only where necessary in invention applications to permit the applicant to make sure that at least one of his claims expresses all of his invention without including too much.[13]

[13] The Reports of the Senate and House Committees which reported bills resulting in the enactment of Title 35 dwell at length on changes in statutory language in other sections in which changes in practice were intended, but each report passes over Sections 111 and 112, with the identical sentence: "The next group of sections relates to the application for a patent." S. Rept. No. 1979, 82d Cong., 2d Sess., p. 6; H. Rept. No. 1923, 82d Cong., 2d Sess., p. 7. The reviser's note following Section 112 states in part:

"The clause relating to the claim is made a separate paragraph to emphasize the distinction between the description and the claim or definition, and the language is modified."

It also should be pointed out that Congress did not change the statutory scheme of fixing fees in design cases solely on

Petitioner also contends that the decision below is incorrect because of 35 U.S. 121, providing that "If two or more independent and distinct inventions are claimed in one application, the Commissioner may require the application to be restricted to one of the inventions." Section 121 goes on to provide that if the invention required to be taken out of the application is applied for in a "divisional-application" under Section 120, it will receive the benefit of the original application, and neither invention may be used as a reference against the validity of the other in the Patent Office or the courts. Petitioner's argument is that the decision below deprives design applicants of a "substantial legal right" to have the Commissioner of Patents require division of applications (Pet. 7). Further, he contends, it deprives the Patent Office of the "authority and means of orderly procedure" of requiring division in design cases (Pet. 8). But there is nothing in the decision implying that, if it appears to the Commissioner that an applicant's drawings show two separate and distinct designs, he may not require that the drawings showing one of the designs be omitted from the application and filed separately. There is likewise no intimation in the opinion that the second application, if Section 120 is complied with, will not receive the statutory protection afforded in Section 121. Petitioner gratuitously states that the only "units of invention" which can be so separated by the Commissioner are claims (Pet. 10),

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the basis of the length of time of the monopoly claimed, while in invention cases, the fee is based in part on the number of claims. See 35 U.S.C. 41(a)(1), (2), (3).

but cites no authority or practice for such an arbitrary limitation on the Commissioner's power and on the rights of applicants.

4. Finally, it should be said that the case is of no general importance. As the court below noted (Pet. App. 23), the petitioner can receive full protection for his design simply by stating his claim as follows: "The ornamental design for a floor waxer substantially as shown."[11] Now that the Court of Customs and Patent Appeals has corrected the practice of limiting the design patent applicant to a showing of only one embodiment of his design, applicants may show as many things as they believe can embody their design. No greater protection would be added by allowing multiplication of claims.

CONCLUSION

For the foregoing reasons, the petition for a writ of certiorari should be denied.

Respectfully submitted,

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FEBRUARY 1960.

[11] So far as the record discloses, the petitioner has made no attempt to amend his application in the form suggested by the court. Amendments are permitted under Patent Office Rules 116–127, 37 C.F.R. 1.116–1.127.

APPENDIX

Statutes and Rules Involved

1. Title 35, United States Code, provides in pertinent part:

§ 41. *Patent fees*

(a) The Commissioner shall charge the following fees:

1. On filing each application for an original patent, except in design cases, $30, and $1 for each claim in excess of twenty.

2. On issuing each original patent, except in design cases, $30, and $1 for each claim in excess of twenty.

3. In design cases: For three years and six months, $10; for seven years, $15; for fourteen years, $30.

* * * * *

§ 101. *Inventions patentable*

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

§ 111. *Application for patent*

Application for patent shall be made by the inventor, except as otherwise provided in this title, in writing to the Commissioner. Such application shall include: (1) a specification as prescribed by section 112 of this title; (2) a drawing as prescribed by section 113 of this title; and (3) an oath by the applicant as prescribed by section 115 of this title. The application must be signed by the applicant and accompanied by the fee required by law.

§ 112. *Specification*

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

§ 113. *Drawings*

When the nature of the case admits, the applicant shall furnish a drawing.

* * * * *

§ 121. *Divisional applications*

If two or more independent and distinct inventions are claimed in one application, the Commissioner may require the application to be restricted to one of the inventions. If the other invention is made the subject of a divisional application which complies with the requirements of section 120 of this title, it shall be entitled to the benefit of the filing date of the original application. A patent issuing on an application with respect to which a requirement for restriction under this section has been made, or on an application filed as a result of such a requirement, shall not be used as a reference either in the Patent Office or in the courts against a divisional application or against the original application or any patent issued on either of them, if the divisional application is filed before the issuance of the patent on the other application.

* * * * *

§ 171. *Patents for designs*

Whoever invents any new, original and ornamental design for an article of manufacture

may obtain a patent therefor, subject to the conditions and requirements of this title.

The provisions of this title relating to patents for inventions shall apply to patents for designs, except as otherwise provided.

2. The pertinent provisions of the Patent Office Rules of Practice, 37 C.F.R. 1.1, *et seq.*, are as follows:

Rule 75 (37 C.F.R. 1.75)
Claim

* * * * *

(b) More than one claim may be presented: Provided they differ substantially from each other and are not unduly multiplied.

* * * * *

Rule 151 (37 C.F.R. 1.151)
Rules applicable

The rules relating to applications for patents for other inventions or discoveries are also applicable to applications for patents for designs except as otherwise provided.

Rule 152 (37 C.F.R. 1.152)
Drawing

The design must be represented by a drawing made in conformity with the rules laid down for drawings of mechanical inventions and must contain a sufficient number of views to constitute a complete disclosure of the appearance of the article.

Rule 153 (37 C.F.R. 1.153)
Title, description and claim

The title of the design must designate the particular article. No specific description, other than a reference to the drawing, is ordinarily required or permitted. The claim shall be in formal terms to the ornamental design for the article (specifying name) as shown, or as shown and described. More than one claim is neither required nor permitted.

* * * * *

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In the Supreme Court of the United States

OCTOBER TERM, 1959.

No. 622.

DON L. RUBINFIELD,
Petitioner,

vs.

ROBERT C. WATSON,
Commissioner of Patents,
Respondent.

PETITIONER'S REPLY BRIEF.

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PETITIONER'S REPLY BRIEF.

Petitioner replies to certain matters raised by the brief for respondent, as follows:

1. Jurisdiction.

By footnote 1, on page 1, of respondent's brief, there is reference to, but not incorporation of, an argument concerning jurisdiction that had been given for the respondent in *other* cases in briefs filed therein by the Solicitor General.

Counsel for petitioner does not have access to those briefs at this time and is unaware of the argument there presented. However, in support of jurisdiction, it is to be observed:

(a) As recently as June 25, 1948, Congress recognized the jurisdiction of this Court in cases such as this by enacting 28 U. S. C. 1256, which provides:

> "Cases in the Court of Customs and Patent Appeals *may be* reviewed by the Supreme Court by writ of certiorari."

(b) As recently as April 12, 1954, this Court recognized its jurisdiction in cases such as this by adopting its present Revised Rules of the Supreme Court, including clause 2 of Rule 19, which clause provides:

> "The same general considerations outlined above will control in respect of petitions for writs of certiorari to review judgments of the Court of Claims, or of the *Court of Customs and Patent Appeals*, or of any other court whose determinations are by law reviewable on writ of certiorari."

(c) *If* this Court did not have jurisdiction by writ of certiorari to the Court of Customs and Patent Appeals, then this petitioner, who has been deprived of a patent by the lower Court's ruling of law, which is contrary to the statutes and in conflict with decisions of this Court, is denied any review whatever of such an erroneous ruling of law. The petitioner, if denied a patent under the ruling below, will not have an opportunity of trying out the same questions of a right to patent protection in any other court. In short, the ruling of law by the Court of Customs and Patent Appeals below, unless reviewed and reversed by this Court, is *final*.

(d) *If* the petitioner had elected another available avenue of appeal from the decision of the Patent Office, that is by filing a civil action, under the provisions of 35 U. S. C. 145, against the Commissioner of Patents in the District Court for the District of Columbia (instead of appealing to the Court of Customs and Patent Appeals under the provisions of 35 U. S. C. 14), then the petitioner, if unsuccessful in the District Court, would have had the right to appeal under the provisions of 28 U. S. C. 1291 to the Court of Appeals for the District of Columbia. From an unsuccessful appeal to the Court of Appeals for the District of Columbia, review may be sought by peti-

tioning the Supreme Court for a writ of certiorari under the provisions of 28 U. S. C. 1254. Thus, if that alternative avenue of appeal had been chosen by petitioner, there would have been a right of one appeal plus an unquestioned right to seek further review by petitioning this Court for a writ of certiorari.

A denial of the right even to seek review of the ruling made by the *single court* that has heard petitioner's case, by a suggestion of lack of jurisdiction, is to be compared with the opportunities for review possible under the other avenue of appeal from the Patent Office. Such attempted denial of any possibility of review is also to be compared with the usual right of at least one appeal in other types of litigation.

2. Design Patents Are Also Patents for Inventions.

The brief for respondent raises a new theory or concept not encountered in the arguments below nor found in any of the decisions or literature. Repeatedly, the respondent's brief attempts to make a distinction, other than distinctions expressed in the statutes, between "*invention* patents" on the one hand and "*design* patents" on the other hand. Based upon such a premise, there is then advanced upon behalf of respondent the argument that such a distinction warrants the difference in the treatment given by the Patent Office, in respect to claiming of the disclosed inventions, between petitioner's application for a patent on his design and a so-called "*invention* patent" application.

The premise is in error because *all* patents granted by the Commissioner of Patents under the statutes are for *inventions*. That designs must embody *inventions* to be patentable is basic to our patent laws. The statute authorizing design patents, 35 U. S. C. 171, states, in part, that:

> "Whoever *invents** any new, original and ornamental design for an article of manufacture may obtain a patent therefor, subject to the conditions and requirements of this title."

Too many to cite are the decisions of the Patent Office and the courts repeating the requirements that design patents like non-design patents must embody inventions.

There is thus no warrant for attempting to justify the denial of the right of a design patent applicant to equal treatment under the patent statutes authorizing the *claiming of inventions* in both design and non-design cases. The only lawful distinctions are those expressed by the statutes, because the last paragraph of 35 U. S. C. 171 states that:

> "The *provisions of this title* relating to patents for inventions shall apply to patents for designs, except as otherwise provided."

3. The Statutory Function of Claims.

On page 10 of the brief for respondent, there is stated the following:

> "Since the function of the claim *in the design patent* is merely to refer the reader to the drawings, the necessity of permitting an inventor to express his invention in more than one claim, recognized in *invention* patents where the words of the claims are all important, does not exist in patent design cases."

The view there expressed is in conflict with the *only statute* which authorizes and requires claims in any patent, design or non-design. There is *no statute* making

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* Comparable with 35 U. S. C. 101 which provides: "Whoever *invents* or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title."

an exception in design patent cases to this sole authorization for patent claims found in 35 U. S. C. 12, to-wit:

> "The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention."

The statutes do not provide any authority for the suggestion that "the function of the claim in the design patent is merely to refer the reader to the drawings."

4. This Court Has Recognized Plural Claims in Design Patents.

The respondent's brief has cited some decisions of the Commissioner of Patents supporting his own rule allowing but the one claim in design cases notwithstanding the lack of statutory basis for his decisions. However, this Court has passed on design patents with plural claims and did not rule against having plural claims because in a design patent.

This Court passed on a design patent having plural claims and held the patent with nineteen claims valid, in the case of:

Dobson et al. v. Hartford Carpet et al., 114 U. S. 439.

In another case involving a design patent having plural claims, this Court held one claim invalid and remanded to the trial court the question of the validity of two additional claims over the prior art. All three claims were verbal claims rather than merely formal claims referring to the drawing. There was no question as to the propriety of having three claims. This was the case of:

New York Belting Co. v. New Jersey Spring Co., 137 U. S. 445.

No statutory authority has intervened since those cases to support the Commissioner of Patents' decisions in favor of his own Patent Office Rule 153 curtailing the rights of those making *design inventions* to adequately claim their inventions under the general patent statutes.

5. Admission That 35 U. S. C. 121 Enacted in 1952 Should Apply.

It appears that the brief for respondent, in the last half of page 13, concedes that the provisions of 35 U. S. C. 121* should govern applications for patents on design inventions. Because the practice is so universally followed, and because no other manner of dealing with questions of division is known, it should be readily conceded that division under 35 U. S. C. 121 is always a division between *claims*. No case has been cited contrary to the statement that the only "units of invention" capable of being separated are claims.

Thus, when it is admitted, upon behalf of respondent, that in design cases the Commissioner *may require separation*, and upon the portion separated from the first application being filed in second application, it may be granted the statutory protection expressed in 35 U. S. C. 121, this concedes the full application of 35 U. S. C. 121 to design patent applications. If, as petitioner has insisted without success in the Patent Office and in the Court below, the provisions of 35 U. S. C. 121 apply to design patent applications, then there must be permitted a plurality of claims in design cases.

It inherently follows that there must be *multiple* claims to a *multiple* of "independent and distinct in-

* 35 U. S. C. 121 is new in the patent statutes and its provisions appear for the first time in the Patent Act of 1952.

ventions" in order for the Commissioner to require restriction to *one claimed* invention and for the applicant to be assured the statutory protection of 35 U. S. C. 121 when he files a divisional application on the *other claimed invention.*

In the proceedings in the Patent Office, there was made the request upon behalf of petitioner for a requirement of a restriction *under the provisions of* 35 U. S. S. 121 if the Patent Office considered that there were "two or more independent inventions claimed in one application." The Patent Office steadfastly and studiously refused to make such a requirement. The above admission now contained in the brief on behalf of respondent would appear to confess error on the part of the Patent Office and the Court below.

CONCLUSION.

The need for grant of a writ of certiorari has been demonstrated.

Respectfully submitted,

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February, 1960